I. Remarks

This Response addresses the Office Action mailed on September 30, 2005. A diligent effort has been made to respond to the rejections contained therein, and reconsideration and allowance is respectfully requested in view of this Response.

As an initial matter, the Examiner appears not to have reviewed or initialed the non-patent references supplied by Applicant in the Information Disclosure Statement ("IDS") submitted to the Office on November 15, 2001. Attached hereto as Exhibit A is a copy of the postcard from the Office acknowledging receipt of the IDS with copies of all fourteen listed references. The postcard evidences the Office's receipt of a properly submitted IDS including copies of the non-patent references. For the Examiner's convenience, Applicant includes with this submission as Exhibit B additional copies of the five (5) listed references and a substitute PTO-1449 listing these references; Applicant requests that the Examiner review these references, make them of record and issue an initialed substitute PTO-1449 to that effect with the next action in the present case.

Claims 1-95 are pending in the present application. The Examiner rejected claims 1-95 under 35 U.S.C. §103(a) as obvious in view of U.S. Published Patent Application No. US2004/0010517 filed by Fetherston ("Fetherston"). Applicant respectfully traverses these rejections for at least the reasons set forth below.

A. Fetherston fails to disclose interaction with process documentation as recited in claims 1-95

With regard to claim 1, the Examiner has stated that "Fetherston discloses ... b) providing access to process documentation related to a process associated with the selected employment action, wherein the process is designed to minimize potential for non-compliance with the employment laws (health and safety, etc.), wherein the process documentation guides the agent through the process via interactions between the agent and the process documentation

via the user input and output devices (wizard)." Office Action, ¶3. The Examiner cites paragraph 12 and claims 1-2 of Fetherston for this proposition. Applicant respectfully submits that these cited passages fail to disclose, teach, or suggest the guided decision making required by recited limitation b) of claim 1.

The closest Fetherston appears to come to the claim's requirement appears to be in paragraph 49 where Fetherston states that "[t]he navigator guides the user on a step-by-step basis on the actions necessary to implement compliance management procedures, through the system and through the wider networks to other systems." Fetherstron, ¶49. However, this statement still falls short of the required limitation. The invention of claim 1 requires that "the process documentation guides the agent through the process via interactions between the agent and the process documentation." The limitation requires interactivity with the process documentation with potential branching within the process documentation based upon prior interactions. In contrast, Fetherston provides what appears to be a linear roadmap. The system of Fetherston fails to provide the interactivity with the process documentation as required in claim 1. Applicants invention allows for guided decision making that dynamically adapts based not only on the employment situation but also on the prior actions by the agent.

Independent claims 1, 75, 90, 94 all include an "interactions between the agent and the process documentation" requirement. For at least this reason, Applicant respectfully requests that the Examiner withdraw the rejection of these claims, and the claims depending from them, namely claims 1-95. *See In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988)(" Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious."). Since Fetherston fails to disclose, teach or suggest guided decision making through interactive process documentation, Applicant requests that Examiner issue a Notice of Allowance indicating allowability of pending claims 1-95.

B. Fetherston fails to disclose an employment law information source as recited in claims 13-19 and 75-76

In addition, with regard to claims 13-19 and 75-76, Applicant asserts that the Fetherston fails to disclose, teach or suggest use of an employment law information source. In stark contrast, Fetherston clearly discloses use of a master database for storing compliance criteria that is populated and managed by the organization purchasing and using the system. Fetherston, ¶12. Claims 13-19 and 75-76 require communication with an external source of compliance information. This capability provides a significant advantage to the users of the claimed systems of the present application. The inventions claimed allow an external employment law information source to take on the onerous task of populating and maintaining the compliance criteria associated with employment law compliance. Fetherston leaves this burden squarely on the shoulders of the organization purchasing the described system. Fetherston, ¶12. In fact, Fetherston explicitly **teaches away** from systems where the database designer controls the relationships in the compliance database. Fetherston, ¶51. The claimed invention provides for an external law source to populate the original compliance criteria and also to maintain the criteria as employment law requirements evolve over time. For at least this additional reason, Applicant respectfully requests that the Examiner withdraw the rejection of claims 13-19 and 75-76.

C. The Examiner has failed to establish a *prima facie* case of obviousness of claims 1-95

Moreover, the Examiner states that "Fetherston fails to disclose sending the generated compliance report to one or more report agents of the employer via an output device associated with each." This statement appears in connection with each of independent claims 1, 75, 90, and 94. Office Action, ¶¶4, 60, 77 & 83 (respectively). The Examiner then concludes that "it would have been obvious to one of ordinary skill to further forward the report to the legislative body to further/finally fulfill the compliance requirement set by said legislative body." Office Action,

¶¶5, 61, 78 & 84. Based on these statements, Applicant respectfully asserts that the Examiner has failed to establish a *prima facie* case of obviousness with respect to each of the pending independent claims.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. ... Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. §2142. In the present situation, the Examiner has stated that the references fails to disclose a limitation of the presented independent claims. The Examiner has followed that statement with an assertion that an action **different** from the claimed requirement would be obvious. The claims require sending a report to **one of more report agents of the employer**. The Examiner has asserted that it would have been obvious to forward the report to **the legislative body**. Consequently, Applicant respectfully submits that the Examiner's rejection fails to teach or suggest all the claim limitations.

Applicant requests that the Examiner reconsider his rejection of independent claims 1, 75, 90, and 94 for at least this additional reason. As the remaining claims depend from these independent claims, Applicant requests the withdrawal of the Examiner's obviousness rejections for these claims as well. *See In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988). Applicant, therefore, requests that Examiner issue a Notice of Allowance indicating allowability of pending claims 1-95.

D. The Examiner has failed to specify the relevant teachings of Fetherston to support rejections of claims 2-44, 68-74, 91-93 and 95

Next, Applicant fails to see where Fetherston discloses the limitations of claims 2-44, 68-74, 76-89, 91-93, and 95. In the Office Action, the Examiner has only provided the conclusion that Fetherston discloses the limitations of these claims without providing any supporting citation. Applicant respectfully requests that the Examiner withdraw these rejections or, in the

next action, provide citation to Fetherston supporting the Examiner's position in order to give the Applicant a fair opportunity to reply.

"After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the office action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate..." M.P.E.P. §706.02(j). In the present action, the Examiner has failed to state the relevant teachings of the prior art that support his rejection of claims 2-44, 68-74, 76-89, 91-93, and 95. Rather, the Examiner has in each instance provided a conclusory statement that "Fetherston discloses" the recited limitation of the particular claim in question.

"It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply." M.P.E.P. §706.02(j). The nature of the Examiner's rejection of claims 2-44, 68-74, 76-89, 91-93, and 95 deprives the Applicant of a fair opportunity to reply. Consequently, Applicant respectfully requests that the Examiner withdraw these rejections or provide "the relevant teachings of the prior art" to afford Applicant a fair opportunity to respond to these rejections.

E. The Examiner has failed to provide evidence to support rejections of claims 45-67

Finally, in the rejection of claims 45-67, the Examiner has acknowledged that Fetherston fails to disclose the recited limitations of these claims. Office Action, ¶49. The Examiner has indicated that these limitations "were well known by one of ordinary skill" and "known in employment law regulation." Office Action, ¶¶50-51.

"In limited circumstances, it is appropriate for an examiner ... to rely on "common knowledge" in making a rejection, however, such rejections should be judiciously applied." M.P.E.P. §2144.03. In this situation, Applicant believes that reliance on "common knowledge" is inappropriate. The claimed inventions are directed to a highly specialized area of legal

compliance requiring a significant degree of education and experience. Applicant, therefore, respectfully asserts that these limitations are not amenable to rejection on an assertion of common knowledge. "[A]ssertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art." *Id.* Applicant requests that the Examiner withdraw the rejection of these claims or provide evidence supporting his contention in the next action.

II. Conclusion

For all the reasons discussed above, Applicant respectfully requests that the Examiner do the following:

1. withdraw his rejection of pending claims 1-95; and
2. allow all pending claims so that a patent containing claims 1-95 may issue in due course.

Because this paper is filed within six months of September 30, 2005, the undersigned has submitted this response with a petition for a three month extension of time under 37 CFR 1.136(a) and provided for the fee of $510.00 for the extension of time. If the undersigned is incorrect in his belief regarding this fee, the Commissioner is authorized to charge any underpayment of fees to deposit account 50-3091.

The Examiner is invited to contact the undersigned if such contact would assist in the further prosecution of this case.

Respectfully submitted
on March 30, 2006,
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